

I. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-78 are pending in the application. Claims 1, 23, 42, 51, 56, 62, 68, and 74 are independent.

The Advisory Action of January 20, 2004 states that the Declaration received December 18, 2003 is ineffective in overcoming the applied art. The Examiner states that the Applicant's averments of diligence, coupled with evidence dated May 1, 2000, are insufficient, and that "applicant is required to show data in which diligence is accounted for during the entire time", referring to MPEP 2138.06. Applicants respectfully traverse such a requirement.

The Examiner is believed to be confusing that evidence required to make a proper showing in a Rule 131 Declaration with that evidence required by the Board to demonstrate prior inventorship in an interference contest. MPEP 2138, to which the Examiner refers, is clearly directed to Interference Practice. However, MPEP 715.07 (that portion of the MPEP which is directed toward Rule 131 Declarations) clearly

cautions examiners that these evidentiary requirements are very different:

Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, **whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects.** *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

(emphasis supplied)

The MPEP is clear as to the reasoning behind this different treatment of the evidence required in an interference and that evidence required in a Rule 131 Declaration:

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the

same as what is required in the  
'interference' sense of those terms." *Id.*;  
accord, *In re Borkowski*, 505 F.2d 713, 718-  
19, 184 USPQ 29, 33 (CCPA 1974).

The courts are in accord with this treatment. See  
*Herman v. William Brooks Shoe Co.*, 39 USPQ2d 1773, 1777 (S.D.  
N.Y. 1996), "the PTO is required to accept Rule 131 Affidavits  
at face value, and without investigation."

In fact, the PTO also agrees with this view. Attached  
is a copy of a Rule 131 Declaration submitted by Vaughn Keenan  
(one of the Rule 131 declarants in the present application)  
during the prosecution of Application No. 09/810,431 (now U.S.  
Patent No. 6,540,366)<sup>1</sup>. This Declaration was found by the PTO to  
be effective in overcoming a rejection based on Rodriguez (U.S.  
Patent No. 6,179,426<sup>2</sup>. Note that the diligence showing in this  
declaration was much less than that already submitted in the  
subject application, and is in accordance with the views of the  
courts and the PTO as to the evidentiary requirements of Rule  
131 declarations. Note also that the effective date of  
Rodriguez (March 3, 1999) is the same effective date as the

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<sup>1</sup> The Examiner may make use of this Declaration as further evidence of conception and diligence from a time prior  
to March 3, 1999.

<sup>2</sup> In the January 20, 2004 Advisory Action, the Examiner indicated that Rodriguez "will be used against the claims  
once the applicant overcomes the establishment of diligence requirement."

applied art (Vanderwerf) in the subject application, since Vanerewerf claims priority to Rodriguez. Accordingly, the Rule 131 Declaration in the subject application will also be effective in overcoming any rejection based on Rodriguez.

The Examiner will also find that the exhibits in the attached Keenan declaration are very similar to those submitted in the subject application. This is because they relate to the same project. Since the PTO has already found that the Vanderwerf/Rodriguez patents have been antedated by a Rule 131 Declaration containing averments and evidence similar to but less stringent than that already submitted in this case, and since the courts and the PTO have provided clear guidance on the requirements for Rule 131 declarations and Applicants have more than complied with those requirements, Applicants respectfully submit that the Rule 131 Declaration submitted in this case is fully effective in overcoming the Vanderwerf/Rodriguez patents.

The Examiner's current view also raises the troubling question of how much evidence will be required to demonstrate diligence. Since interference case law suggests that a gap of a few weeks may defeat a claim of diligence, the Examiner could presumably require documentary evidence of weekly or even daily progress. Applicants and the Examiner may be trading

Declarations and Office Actions for years before the Examiner is finally satisfied. This would clearly be excessively burdensome on Applicants and the PTO. This is the reason that the MPEP cautions that the Examiners are not to adjudicate such issues. Applicants are permitted to stand upon the averments made in the Rule 131 Declaration, and Applicants elect to do so here.

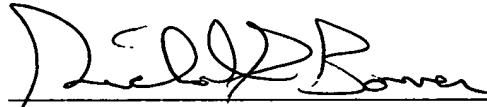
Accordingly, Applicants respectfully submit that the Rule 131 Declaration in this case is effective in antedating the applied art.

In view of the above remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3507. All

correspondence should continue to be directed to our address  
given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard P. Bauer", written over a horizontal line.

Attorney for Applicants  
Richard P. Bauer  
Registration No. 31,588

Patent Administrator  
KATTEN MUCHIN ZAVIS ROSENMAN  
525 West Monroe Street  
Suite 1600  
Chicago, Illinois 60661-3693  
Facsimile: (312) 902-1061